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OFFICE OF PETITIONS

In re Application of
Jeffers, et al. :
Application No. 09/992,840 :
Filed: 6 November, 2001 :
Attorney Docket No. 15966-557A (Cura 57A) :

ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 1 July, 2005

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the application was filed on 6 November 2001, without, *inter alia*, a fully executed oath or declaration;
- the Office mailed a Notice of Missing Parts (*inter alia*, oath/declaration) on 5 December, 2001 (the 5 December Notice), however, it appears that the 5 December Notice was not received by Petitioner, and ultimately the Office re-mailed the Notice on 22 January, 2004 (the 22 January Notice), with a response due absent extension of time on or before 22 March 2004;
- on 22 June, 2004, Petitioner filed, *inter alia*, a request and fee for a three- (3-) month extension of time, an oath/declaration signed by the inventors (on behalf of themselves and) save for the non-responsive inventor Elma Fernandes (Ms. Fernandes), and the instant petition (statements by Ivor Elrifi (Reg. No 39,529) and Kristin E. Konzak (Reg. No. 44,848) along with a statement by Nicole Carlucci and a copy of a transmittal letter dated 3 May, 2004, however, the referenced transmittal document was explicit that Petitioner transmitted only the oath/declaration (with assignment), but not the entire application (specification: description abstract claims and drawings) to the non-signing inventor Ms. Fernandes, and so the petition was dismissed on 16 September, 2004, with a grant of two months to file a renewed petition;
- the instant petition was filed on 1 July, 2005—more than nine months after dismissal of the original petition—and Petitioner, apparently ignoring the discussion of the matter in the 16 September, 2004 decision—points to a transmittal letter of 17 September, 2004, that states expressly: “Enclosed, please find Assignment and Combined Declaration and Power of Attorney for Cura 57A.”

It appears that once again the entire application was not transmitted.

Moreover, it appears that the instant application went abandoned after midnight 16 November, 2004, for failure to reply to the 16 September, 2004, decision, absent extension of time, on or before 16 November, 2004.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the

fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

- (b) In addition to meeting the requirements of paragraph (a)of this section, the oath or declaration must also:
- (1)Identify the application to which it is directed;
 - (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, Including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
 - (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted.

And a reasonable effort must be made to ascertain a current or last known address.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

¹ See: MPEP 409.03(b).

CONCLUSION

The instant application appears to be abandoned for failure to reply to the 16 September, 2004, decision, absent extension of time, on or before 16 November, 2004.

The materials submitted thus far clearly evidence that Petitioner provided a copy of the entire application to the non-signing inventor. Moreover, there is no evidence that Petitioner had made a diligent effort to ascertain and inform the Office of the then-current and valid last known postal address of Ms. Fernandes.

Petitioner should submit a copy of the transmittal letter and should state the address in the petition over Petitioner's signature and registration number.

Therefore, the instant petition hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:²

By mail: Commissioner for Patents³
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

² On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognitice/cfax062005.pdf>.)

³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

Telephone inquiries regarding this decision should be directed to the undersigned at 703-305-9199.



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Office of Petitions